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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Fort Collins, CO 80527-2400

EXAMINER

GATES, ERIC ANDREW

ART UNIT

PAPER NUMBER

3722

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,649

Applicant(s)

SCHUDER ET AL.

Examiner

Eric A. Gates

Art Unit

3722

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-13, 21-30 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 and 26 is/are allowed.
- 6) ☒ Claim(s) 9-13, 21-24, 27-30, and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed 7 February 2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9, 10, 21-24, 27-29, 36, 37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson (U.S. Patent 3,847,718) in view of Card et al (U.S. Patent 3,739,412).
4. Regarding claim 9, Watson discloses a bookbinding system, comprising: two or more sheets bound into a text body 15 having an exposed spine bounded by two exposed side hinge areas (not labeled, see figure 3); an adhesive dispenser (in the form of a roll, not shown, see column 2, lines 63-67) configured to apply a solid pressure sensitive adhesive film 40 between a cover 32 (see column 3, lines 5-13, substrate 12 may be made of a width sufficient to form cover 32) and the side hinge areas of the text

body 15; and a cover binder (not shown, see column 4, lines 38-46 and column 5, line 65 to column 6, line 2) configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

Watson does not disclose a sheet binder configured to bind with an adhesive two or more sheets into an adhesively bound text body. Card et al. teaches the use of a sheet binder configured to bind with an adhesive 3 two or more sheets 1 into an adhesively bound text body for the purpose of creating a bound text body that strengthens the binding of the final book. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the system of Watson with the sheet binder of Card et al. in order to have a bound book in which the sheets are more strongly bound together.

5. Regarding claim 10, the modified invention of Watson discloses wherein the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film 40 to the cover in a series of spaced-apart strips (see figure 7).

6. Regarding claim 21, Watson discloses a bookbinding system, comprising: two or more sheets bound into a text body 15 having an exposed spine bounded by two exposed side hinge areas (not labeled, see figure 3); an adhesive dispenser (in the form of a roll, not shown, see column 2, lines 63-67) configured to apply a solid pressure sensitive adhesive film 40 between a cover 32 (see column 3, lines 5-13, substrate 12 may be made of a width sufficient to form cover 32) and the side hinge areas of the text body 15; and a cover binder (not shown, see column 4, lines 38-46 and column 5, line 65 to column 6, line 2) configured to bind the cover to the side hinge areas of the text

body by applying pressure to the cover, wherein the adhesive dispenser applies the solid pressure sensitive adhesive film to the cover before the cover binder contacts the applied solid pressure sensitive adhesive to the side hinge areas of the text body (as seen in figure 4).

Watson does not disclose a sheet binder configured to bind two or more sheets into a text body. Card et al. teaches the use of a sheet binder configured to bind with an adhesive 3 two or more sheets 1 into an adhesively bound text body for the purpose of creating a bound text body that strengthens the binding of the final book. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the system of Watson with the sheet binder of Card et al. in order to have a bound book in which the sheets are more strongly bound together.

7. Regarding claim 22, Watson discloses a bookbinding system, comprising: two or more sheets bound into a text body 15 having an exposed spine bounded by two exposed side hinge areas (not labeled, see figure 3); an adhesive dispenser (in the form of a roll, not shown, see column 2, lines 63-67) configured to apply a solid pressure sensitive adhesive film 40 between a cover 32 (see column 3, lines 5-13, substrate 12 may be made of a width sufficient to form cover 32) and the side hinge areas of the text body 15, wherein the adhesive dispenser additionally applies the solid pressure sensitive adhesive film between the cover and the exposed spine of the text body (by applying it to the cover first as seen in figure 4, the adhesive 40 is between the cover and the exposed spine of the text body prior to the cover binding step); and a cover binder (not shown, see column 4, lines 38-46 and column 5, line 65 to column 6, line 2)

configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover, wherein the cover binder binds the cover to the spine of the text body by applying pressure to the portion of the cover positioned over the spine of the text body.

Watson does not disclose a sheet binder configured to bind two or more sheets into a text body. Card et al. teaches the use of a sheet binder configured to bind with an adhesive 3 two or more sheets 1 into an adhesively bound text body for the purpose of creating a bound text body that strengthens the binding of the final book. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the system of Watson with the sheet binder of Card et al. in order to have a bound book in which the sheets are more strongly bound together.

The modified invention of Watson does not disclose that the cover binder positions a portion of the cover over the spine of the text body. However, it would have been obvious for the cover binder to have automatically positioned a portion of the cover over the spine of the text body using of the cover binder for the purpose of increasing the speed and quality of the binding system, because it has been held that providing automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.

8. Regarding claim 23, the modified invention of Watson discloses wherein the adhesive dispenser applies the solid pressure sensitive adhesive film 40 as a single continuous strip (one strip of the two strips 40). Watson does not disclose that the width dimension is wider than the exposed spine of the text body. However, it would have

been an obvious matter of design choice to make the width of the adhesive film 40 of whatever relative size desired for the purpose of providing a greater area of adhesion between the side hinge area and the cover, since such a modification would have involved a mere change in the proportions of component. A change in proportion is generally recognized as being within the level of ordinary skill in the art.

9. Regarding claim 24, the modified invention of Watson discloses in an alternative embodiment wherein the adhesive dispenser applies the solid pressure sensitive adhesive film 40 in a series of multiple strips over an area corresponding to the side hinge areas and the exposed spine of the text body (the strips 40 surround the area as defined, as seen in figure 7).

10. Regarding claim 27, the modified invention of Watson discloses wherein the cover binder contacts the side hinge areas to the applied solid pressure sensitive adhesive film 40.

11. Regarding claim 28, the modified invention of Watson discloses wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive 40 from a roll of solid sheet adhesive (the solid sheet adhesive that forms adhesive 40 is only a portion of the content of the roll).

12. Regarding claim 29, the modified invention of Watson discloses wherein the adhesive dispenser dispenses from the roll a solid sheet adhesive that comprises a pressure sensitive adhesive 40 composition dispersed on a carrier ribbon 18/19.

13. Regarding claim 36, the modified invention of Watson discloses further comprising a roll of the solid sheet adhesive loaded in the adhesive dispenser (the roll disclosed in claim 9 above is the adhesive dispenser).

14. Regarding claim 37, the modified invention of Watson discloses wherein the cover binder positions the cover over the exposed side hinge areas and the exposed spine of the text body 15 and applies pressure to the positioned cover 32 to activate the pressure sensitive adhesive film 40 (see column 5, line 65 to column 6, line 2).

15. Regarding claim 38, the modified invention of Watson of claim 22 discloses the invention substantially as claimed, as the pressure sensitive adhesive film 40 is activated without applying heat (the heat is used to activate adhesive 14; the film 40 only utilizes the pressure component for activation).

16. Regarding claim 39, the modified invention of Watson discloses wherein the adhesive dispenser applies the spaced-apart strips of the solid pressure sensitive adhesive film 40 respectively over areas of the cover corresponding to the spine and the side hinge areas of the text body (see figure 7).

17. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watson and Card et al. and further in view of Nakamura et al (JP Patent Publication 05038891 A).

18. Regarding claim 11, Watson discloses a bookbinding system, comprising: two or more sheets bound into a text body 15 having an exposed spine bounded by two exposed side hinge areas (not labeled, see figure 3); an adhesive dispenser (in the form

of a roll, not shown, see column 2, lines 63-67) configured to apply a solid pressure sensitive adhesive film 40 between a cover 32 (see column 3, lines 5-13, substrate 12 may be made of a width sufficient to form cover 32) and the side hinge areas of the text body 15; and a cover binder (not shown, see column 4, lines 38-46 and column 5, line 65 to column 6, line 2) configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

Watson does not disclose a sheet binder configured to bind with an adhesive two or more sheets into an adhesively bound text body. Card et al. teaches the use of a sheet binder configured to bind with an adhesive 3 two or more sheets 1 into an adhesively bound text body for the purpose of creating a bound text body that strengthens the binding of the final book. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the system of Watson with the sheet binder of Card et al. in order to have a bound book in which the sheets are more strongly bound together.

The modified invention of Watson does not disclose that the adhesive dispenser comprises a plug-in cartridge housing. Nakamura et al. teaches the use of an adhesive dispenser 33 that dispenses pressure sensitive adhesive tape 2, the dispenser in the form of a plug-in cartridge housing for the purpose of being able to cut and dispense the tape from the backbone attaching device with the ability to easily remove the cartridge from the device without hindrance by the adhesive tape. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the modified system of Watson with the plug-in cartridge of Card et al. in

order to have an adhesive dispenser that allows for easy replacement of the adhesive tape.

19. Claims 12, 13, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, Card et al., and Nakamura et al., and further in view of Rossini (U.S. Patent 5,261,996).

20. Regarding claims 12 and 13, the modified invention of Watson (as modified by Nakamura et al.) discloses wherein the adhesive dispenser 33 comprises a supply spool 2 disposed within the plug-in cartridge housing 33 and configured to support a roll of pressure sensitive adhesive tape 2 formed from a solid pressure sensitive adhesive film. The modified invention of Watson does not disclose wherein the film is disposed on a carrier ribbon, or wherein the adhesive dispenser comprises a take-up spool disposed within the plug-in cartridge housing and configured to reel-in spent carrier ribbon. Rossini teaches the use of a supply spool 42 configured to support a roll of adhesive tape 34 with a carrier ribbon 48, and which uses a take-up spool 46 disposed within the housing 10 for the purpose of winding up the used carrier ribbon 48. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the modified system of Watson with the ribbon and take-up spool of Rossini in order to have an adhesive dispenser that can use adhesive tape that is supplied with a protective backing to prevent the tape from sticking to the layer underneath it on the roll.

21. Regarding claim 30, the modified invention of Watson of claims 11-13 discloses the invention substantially as claimed.

Allowable Subject Matter

22. Claims 25-26 are allowed. Claim 25 is the independent claim.

23. The following is an examiner's statement of reasons for allowance:

The closest prior art of record is U.S. Patent 3,847,718 to Watson, which was applied to the claims in the office action mailed 15 March 2007. Suffice it to say, the patent to Watson does not disclose "wherein the adhesive dispenser applies between the cover and the side hinge areas a solid pressure sensitive adhesive film that comprises a pressure sensitive adhesive composition laminated to a hot melt adhesive film" as claimed in independent claim 25, and as such does not anticipate the instant invention as disclosed in independent claim 25.

Furthermore, there is no combinable teaching in the prior art of record that would reasonably motivate one having ordinary skill in the art to so modify the teachings of Watson, and thus, for at least the foregoing reasoning, the prior art of record does not render obvious the present invention as set forth in independent claim 25.

Response to Arguments

24. Applicant's arguments filed 7 February 2008 have been fully considered but they are not persuasive.

25. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is found in the references themselves.

26. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

27. For the reasons as set forth above, the rejections are maintained.

Conclusion

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is (571)272-5498. The examiner can normally be reached on Mon-Thurs 8:45 - 6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3722

/Monica S. Carter/

Supervisory Patent Examiner, Art Unit 3722